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REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1.   Rejection of Claims 1, 4-10, 15-22, 24-26, 28-36 and 38-43 under 35 U.S.C. §
      102(e).

Claims 1, 4-10, 15-22, 24-26, 28-36 and 38-43 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,714,797 to Rautila. Claims 1, 20, 31, 42 and 43 are independent.

The Applicant generally traverses the grounds for rejection because Rautila does not teach the invention recited in the rejected claims. Rautila teaches "*a system for ordering, paying for and download[ing] digital product to a mobile device in a cost-effective manner*". Rautila does not teach or suggest a data marking device per the rejected independent claims. Therefore, Rautila does not anticipate or render obvious independent Claims 1, 20, 31, 42 or 43, or the claims that depend therefrom. For purposes of clarification, however, the Applicant has amended the independent claims recite the bookmarking aspect of storing data marks as taught in the Applicant's specification.

The following discussion addresses the rejection in more detail.

(a) Claim 1. Independent Claim 1 is directed to a data marker integrated device communication system, and recites elements within that data marking system.

In support of the rejection, the Examiner states that Rautila discloses a "*data marker integrated device communication system (Fig. 1)*" and further indicates that support for the "*data marker integrated device*" is found in Col. 1, lines 35-41; Col. 4, lines 40-63; and Col. 5 line 39 through Col. 8 line 3 (spanning four columns of text).

However, as will be seen there is NO support for these contentions found in the cited reference.

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Reference is Not Related

First, Rautila is not related to a data marking device, as that term is used in the preamble and body of the Applicant's claims, or described in the Applicant's specification. Rautila teaches a system for ordering and downloading digital products to a mobile device, as clearly described in the following portion of Rautila's Abstract:

> "A system, method and computer program for ordering, paying for and download[ing] digital products to a mobile device in a cost-effective manner. The mobile device includes a short range transceiver and a network transceiver. The mobile device accesses electronic shop server web sites which contain digital products for sale and hotspot network locations where these digital products may be downloaded to the mobile device via the short range transceiver."

As can be seen, Rautila teaches a method wherein material is downloaded from network hotspots when they are available, thus reducing the costs to download the material through a cell phone. However, nowhere does Rautila teach "bookmarking" of music clips, and the cited reference does not meet the limitations of the Applicant's claims.

Reference Teachings Misinterpreted

Second, the teachings of Rautila have been misinterpreted as a "data marking device" when there is no basis for that conclusion. The Examiner incorrectly relies on the following sections of Rautila as teaching a data marking device.

1. Col. 1, lines 35-41:

> "Once the credit card charge is approved, the operator of the web site will then typically ship the item to the user. In the case where the item ordered is digital in format, such as software, graphics, text, video, or music, the item ordered maybe downloaded into the user's PC, server, lap top, palm computer or other processor-based system."

Note that the above section of Rautila describes ordering a digital item for download, which has nothing but incidental relevance to a data marking device. These teachings of Rautila manifestly lack any description of a data marking device as recited in the independent claims of the instant application. As mentioned previously, the data

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marking device recited in the rejected claims provides for bookmarking broadcast music clips when they are being played as described by the specification of the instant application, including Page 1, Lines 23-35.

   2. Col. 4, lines 40-63:

   "*The electronic shop server 40 provides a menu of digital products supplied from content providers 100 available for purchase by user 20. The user 20 may directly download the digital products from the electronic shop server 40 using the cellular phone capabilities of the mobile station 10. The user may also proceed to a hotspot network 50 to download the digital product using the LPRF capability of the mobile station 10. ...Thus, the user 20 can effectively perform a cost benefit analysis of downloading to the cellular phone in the mobile station 10 versus traveling to a hotspot 50 and downloading the digital product through the much faster short range transceiver 210, shown in FIG. 2.*"

The above section of Rautila describes unambiguously a shop mechanism for ordering goods and having them received through a cellular phone or depending on availability a network hotspot. There is no disclosure of anything which comports to a data marking device, also referred to as a "bookmarking" device in the instant application.

   3. Col. 5 line 39 through column 8 line 3. Since this portion of the Rautila spans a substantial portion of the entire Rautila reference, specifically including four columns of text, it will not be duplicated below. The rejection does not direct Applicant to any specific elements within this block of text, and Applicant is unable to find anything within this section of text which could be considered a description of a data marking device according to the specification of the instant application.

   It should be recognized that the meaning of terms used in the claims is determined by the specification, and cannot be interpreted apart from those teachings.

Not All Claim Limitations are Taught

   Thirdly, the relied-upon reference does not disclose all of claim limitations. The first line of Applicant's Claim 1 recited "a data marker integrated device configured to store one or more data marks" which is not met by the Rautila reference. This element

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not found in Rautila. Since, an anticipation rejection requires that every claim element be taught or inherent in a single prior art reference, Claim 1 is not anticipated by the cited reference.

In order to provide clarity with regard to what is meant by the recited data marks, Applicant has amended Claim 1 and the other independent claims to recite that a data mark is stored in response to bookmarking a broadcast clip as described on page 1, lines 23-27; page 8, lines 18-22; page 9, lines 6-10; and elsewhere of the Applicant's specification.

The Applicant respectfully submits that the cited reference does not teach or suggest the elements of Claim 1. Therefore, the Applicant respectfully asserts that the presently claimed invention is patentable over the cited reference, and the Applicant therefore requests that the rejections of Claim 1, and the claims that depend therefrom, be withdrawn.

(b)   Claim 20.   Independent Claim 20 is directed to a method which recites steps involving storage and use of data marks.

The Applicant respectfully submits that support is similarly lacking for the rejection of Claim 20, as was lacking in the support for the rejection of Claim 1.

In support of the rejection of Claim 20, the Examiner asserts that Rautila discloses "*receiving one or more stored data marks*" as supported by Col. 1, lines 35-41; Col. 6, line 41 through Col. 8, line 3. The Examiner also states that Rautila describes "*transmitting said received one or more data marks*" with support given as Col. 8, lines 37-48.

However, col. 1, lines 35-41 of Rautila do not support the rejection as has been already discussed above with regard to Claim 1. Col. 6, line 41 through Col. 8, line 3 of Rautila is a portion of the block of text the Examiner referenced in support of the rejection of Claim 1. Again, as described with respect to Claim 1, there is no support in these teachings for the transmitting and receiving of data marks.

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Col. 8, lines 37-48 of Rautila were referenced by the Examiner in support of the data marks being received and transmitted. However, this section of the reference only describes the downloading of a digital product. A portion of this section is as follows: *"Referring to FIGS. 4 through 7, once the content or digital product is downloaded into the mobile station 10 it may be transferred from the mobile station 10 to another computer 70..."* There is nothing in the cited passage that addresses data marks; there is only a description of downloading digital content.

The teachings of Rautila have thus been misinterpreted, since the reference does not discuss a data marking device. Rautila does not teach or suggest the use of data marks as that term is discussed in the specification of the instant application. Accordingly, not all claim limitations are met by the Rautila reference as it does not describe data marking and the related steps described in Claim 20 involving data marking.

Therefore, Applicant respectfully requests that the rejection of independent Claim 20, and the claims that depend therefrom, be withdrawn.

(c) <u>Claim 31</u>. Independent Claim 31 is directed to a method which recites steps involving storing, transmitting, and receiving data marks within a wireless Bluetooth protocol configuration.

The Applicant respectfully submits that support is similarly lacking for the rejection of Claim 31 as was lacking in the support for the rejection of Claims 1 and 20.

In support of the rejection, the Examiner asserts that Rautila discloses *"storing a data mark"*; and *"transmitting said stored data mark via a Bluetooth protocol connection"*; purportedly finding support in Col. 1, lines 35-41; Col. 2, lines 5-40; Col. 5, lines 9-22; Col. 6, line 41- Col. 7 line 21. In addition, the Examiner asserts that Rautila discloses *"receiving said transmitted data mark"* and *"transmitting said received data mark via a wireless connection"* with support given as Col. 8, lines 37-48.

Col. 1, lines 35-41 of Rautila were similarly referenced in support of the rejection of Claim 1, and provide no support for data marking as already discussed.

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Col. 2, lines 5-40 of Rautila discusses the use of Bluetooth within a cellular phone device, for example: *"This Bluetooth protocol architecture telephone includes both a cellular telephone and a low-power radio frequency (LPRF) receiver and transmitter. This Bluetooth protocol architecture telephone may act as three phones in one"*.

Col. 5, lines 9-22 of Rautila discusses FIG. 2 with respect to the use of low-power RF signals and cellular phone signals. No discussion of data marks.

Col. 6, line 41 through Col. 7, line 21 of Rautila is a portion of the block of text referenced in support of the rejection of Claims 1 and 20. Again, as described with respect to those claims, there is no support therein transmitting and receiving data marks.

Col. 8, lines 37-48 of Rautila was referenced in support of the data marks being received and transmitted. However, this section of the reference (discussed in relation to Claim 20) again describes the downloading of a digital product as in the other sections of text.

The teachings of Rautila have thus been misinterpreted as the reference does not discuss procedures involving data marking as that term is known in the specification of the instant application. Accordingly, not all claim limitations are met by the Rautila reference as it does not describe data marking and the related steps described in Claim 31 involving data marking.

Therefore, the Applicant respectfully requests that the rejection of independent Claim 31, and the claims that depend therefrom, be withdrawn.

(d)   <u>Claim 42.</u>   Independent Claim 42 is directed to a data marker device communication system and is written in a means-plus-function format.

The Applicant respectfully submits that support is similarly lacking for the rejection of Claim 42 as was lacking in the support for the rejection of Claims 1, 20 and 31.

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In support of the rejection, the Examiner contends that Rautila discloses a *"means for receiving one or more stored data marks"* based on the disclosure of Col. 1, lines 35-41; Col. 6, line 41 through Col. 8, line 3. The Examiner also stated that Rautila describes *"means for transmitting said received one or more data marks"*, and referenced col. 8, lines 37-48 in support.

However, as seen below there is no teaching of data marks by Rautila.

Col. 1, lines 35-41 of Rautila was referenced in support of the rejection of Claims 1 and 20, and as already described, provided no support for data marking.

Col. 6, line 41 through col. 8, line 3 of Rautila is a portion of the block of text references in support of the rejection of Claim 1. Again, as described with respect to Claims 1 and 20, there is no support in these teachings for the transmitting and receiving of data marks.

Col. 8, lines 37-48 of Rautila were referenced in support of the data marks being received and transmitted. However, this section of the reference again describes the downloading of a digital product as in the other references. A portion of this section is as follows: *"Referring to FIGS. 4 through 7, once the content or digital product is downloaded into the mobile station 10 it may be transferred from the mobile station 10 to another computer 70..."* There is nothing in this section of the reference that addresses data marks – only a description of downloading digital content is provided.

The teachings of Rautila have thus been misinterpreted as the reference does not discuss a data marking device nor does it teach means utilizing data marks as those data marks are taught in Applicant's specification. Accordingly, not all claim limitations are met by the Rautila reference as it does not describe data marking and the related steps described in Claim 42 which involve data marking.

Therefore, Applicant respectfully requests that the rejection of independent Claim 42, and the claims that depend therefrom, be withdrawn.

(e)   <u>Claim 43.</u>   Independent Claim 43 is directed to a data marker device communication system written in a means-plus-function format.

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The Applicant respectfully submits that support is similarly lacking for the rejection of Claim 43 as was lacking in the support for the rejection of Claims 1, 20, 31 and 42.

In support of the rejection, the Examiner asserts that Rautila discloses a *"means for storing a data mark"*; and *"means for transmitting said stored data mark via a Bluetooth protocol connection"*; referencing Col. 1, lines 35-41; Col. 2, lines 5-40; Col. 5, lines 9-22; Col. 6, line 41- Col. 7 line 21, for support. In addition, the Examiner asserted that Rautila discloses *"means for receiving said transmitted data mark"* and *"transmitting said received data mark via a wireless connection"*, referencing col. 8, lines 37-48 for support.

As already discussed herein, these sections of the Rautila reference do not provide any support for data marking as recited in the pending claims and described in the specification of the instant application.

The teachings of Rautila do not comport to data marking, as that term is known in the specification of the instant application, as recited in Claim 43. Accordingly, not all claim limitations are met by the Rautila reference as it does not describe data marking and the related steps described in Claim 43 involving data marking.

Therefore, Applicant respectfully requests that the rejection of independent Claim 43, and the claims that depend therefrom, be withdrawn.

(f) <u>Claims 4-10, 15-19, 21-22, 24-26, 28-30, 32-36, 38-43</u>. These claims are dependent claims within the above group of claims.

Each of these dependent claims should be considered *a fortiori* allowable in view of the lack of anticipatory support for the parent claims. However, it should also be appreciated that a number of these references provide additional grounds for patentability. For example, Claim 10 is one such claim that provides separate grounds for patentability.

<u>Claim 10</u>. Claim 10 depends from independent Claim 1 and further describes the server terminal being configured to receive one or more data marks from said

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network device.

As already described with regard to the independent claims, Rautila does not teach the use of data marks. This dependent claim further recites a further aspect of the communication of the data marks to the server.

Accordingly, as the claims within this group of claims depend from parent claims for which argument are put forth traversing the anticipation rejection, these dependent claims should be considered *a fortiori* allowable, while a portion of the claims also provide their own grounds for patentability.

2.   Rejection of Claims 2, 11-14 and 23 under 35 U.S.C. § 103(a).

Claims 2, 11-14 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rautila in view of Tarbouriech et al. (U.S. Patent No. 6,650,877).

The above group of claims depend from independent claims which are patentable for the reasons set forth above. Therefore, these claims are *a fortiori* allowable. Applicant respectfully requests that the rejection of claims 1, 11-14 and 23 be withdrawn.

3.   Rejection of Claims 3, 27 and 37 under 35 U.S.C. § 103(a).

Claims 3, 27 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rautila in view of the published application of Lehtonen, U.S. Publication No. 2001/0049262.

The above group of claims depend from independent claims which are patentable for the reasons set forth above. Therefore, these claims are *a fortiori* allowable. Applicant respectfully requests that the rejection of claims 3, 27 and 37 be withdrawn.

4.   Obviousness Considerations under 35 U.S.C. §103.

Nor would the subject matter of Claims 1-43 be obvious to a person having ordinary skill in the art in view of Rautila, Tarbouriech, and Lehtonen.

None of the references cited by the Examiner, nor the combination thereof, suggests, teaches or provides motivation for a data marking device which stores

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bookmarks of broadcast clips and transmits these wirelessly to a wireless enabled network device that communicates the marks to a server.

The Rautila and Lehtonen references are not directed to data marking devices. Rautila describes a system for ordering downloadable material over a wireless connection (refer to the first sentence of the Rautila Abstract). Lehtonen is directed at a hands-free communication function within a mobile phone.

Tarbouriech is drawn to an apparatus for collecting physical identifiers relating to a real world event being stored. For example, detecting the frequency of a broadcast station being listened to. No teaching, motivation, or incentive for including the wireless communication to a wireless network enabled device for communicating with the server is found in the reference.

Therefore, since there is no suggestion, teaching or motivation which can be found in these references from which a person having ordinary skill in the art would find it obvious to modify the teachings of the product ordering system of Rautila to create a data marker therein to correspond to that described in the Applicant's claims, Claims 1-43 recite structure which is patentable over the cited references for purposes of 35 U.S.C. § 103.

5.   Amendment of Claims 1-2, 5-7, 9-10, 14, 17-19, 20-22, 25, 27-28, 31-33 and 42-43.

Claims 1, 20, 31 and 42-43. Claims 1, 20, 31 and 42-43 were amended to assure a proper understanding of the term 'data mark' as recited in the independent claims. The data marks are described as being stored *"in response to bookmarking of a broadcast clip"*. Claim 20 provides this description within an element reciting *"storing a data mark within a data marking device in response to bookmarking of a broadcast clip"*. Claims 31 and 43 provides this description within an element reciting *"within a data marking device in response to bookmarking of a broadcast clip"*. Claim 42 recites this description within an element given as *"means for storing a data mark within a data marking device in response to bookmarking of a broadcast clip"*. In addition, the

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phrasing *"one or more data marks"* was replaced with *"a data mark"* to simplify the claim language, while it is recognized that this phrasing can include one or many.

Data marks being stored in response to bookmarking of broadcast clips are described throughout the specification, for example page 1, lines 23-27; page 5, lines 25-30; page 8, lines 19-22; page 9, lines 6-10, and so forth.

Claims 2, 10, 14, 18-19, 27-28, 30. Claims 2, 10, 14, 18, 27-28, 30 were amended to correct antecedent basis issues arising from changing the "one or more data marks" in parent claims.

Claims 5-7, 9, 17, 21-22, 25, 32-33 and 35. Claims 5-7, 9, 17, 21-22, 25, 32-33 and 35 were amended to correct typographical errors, and replace the term "via" with the more well known term "through".

None of the amendments herein have been made for the purpose of addressing any anticipation or obviousness rejection or overcoming any cited reference. Nor do any of the amendments narrow the scope of the claims.

6.   Rejection of Claims 1-43 for Non-statutory Double Patenting.

Claims 1-43 were rejected for non-statutory double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,650,534 to John Tree, which is subject to common assignment to Sony Corporation as indicated by the Affidavit filed October 22, 2004.

However, in reviewing the claims of the Tree reference it is readily seen that Claims 1-21 of the Tree patent are directed to a mechanical configuration of an integrated communication port. Applicant contends that there is thus no conflict therein between Claims 1-21 of the Tree patent and the pending claims of the instant application.

By way of example, Claim 1 of the Tree Patent recites:

> *"1. An electronic music marker device with an integrated communication port, comprising: a housing including a main body portion and a cap portion, said cap portion pivotally mounted to said main body portion at a first edge such that said cap portion is configured to pivot about said first edge between an open*

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position and a closed position; and a communication port connected to said housing via a retractable cable; wherein said housing substantially encases said communication port and said retractable cable when said cap portion is in said closed position."

The mechanical nature of the above claim, and the remaining claims in Tree, is in contrast to the claims of the instant application with are drawn to electronic aspects, in particular a wireless communication aspect of a data marking device. The instant application does not claim a mechanical arrangement of a port. Nowhere in the claims of Tree are wireless embodiments claimed, therein no double patenting conflict exists.

If Examiner disagrees with Applicant assertion, Applicant respectfully requests information as to specifically which portions of Claims 1-21 of Tree read on Claims 1-43 of the instant application.

Therefore, Applicant respectfully requests that the double patenting rejection be withdrawn since it appears no conflict appears between Claims 1-21 of U.S. Patent No. 6,650,534 to Tree and Claims 1-43 of the instant application.

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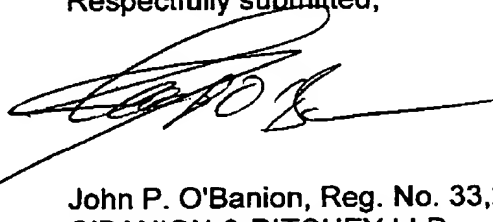Off. Act. Dated: 01/04/2006

6.   Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: _____

Respectfully submitted,

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